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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/332,050	06/14/1999	JAN HOLLER	2466-29	2451

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EXAMINER

NGUYEN, STEVEN H D

ART UNIT	PAPER NUMBER
2665	

DATE MAILED: 01/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/332,050

Applicant(s)

HOLLER ET AL.

Examiner

Steven HD Nguyen

Art Unit

2665

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on 14 June 1999.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 1-13 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-13 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.

4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As claim 1, line 5, the recitation “the port” is vague and indefinite because it’s does not refer to any previous elements.

As claim 1, lines 7 and claim 4, lines 7, the recitation “the address of the exit port” is vague and indefinite because it’s does not refer to any previous elements.

As claim 1, lines 7-8 and claim 4, lines 3, the recitation “the entry port” is vague and indefinite because it’s does not refer to any previous elements.

As claim 1, lines 8 and claim 4, lines 8, the recitation “the address of the entry port” is vague and indefinite because it’s does not refer to any previous elements.

As claim 1, lines 8-9 and claim 4, lines 8, the recitation “the exit port” is vague and indefinite because it’s does not refer to any previous elements.

As claim 4, lines 5, the recitation “the address of the output port” is vague and indefinite because it’s does not refer to any previous elements.

As claim 4, lines 10, the recitation “the output port” is vague and indefinite because it’s does not refer to any previous elements.

There is insufficient antecedent basis for this limitation in the claim. Please clarify, so the meter and boundary of the claims can be determined.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-2, 4 and 6-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Doshi (USP 5568475).

Regarding claims 1 and 4, Doshi discloses (Figs 1-7 and col. 1, lines 14 to col. 11, lines 32) a telecommunication network (Fig 1) comprising an ATM network (Fig 1, ATM switches) having means connected to the ATM network for identifying a telephone call which enters the ATM network at a first port (Col. 5, lines 65 to col. 6, lines 42 used for identifying a first port which a telephone call enters the ATM network, Port 27-1 will be associated with incoming trunk), means for identifying the port in the ATM network through which the call is to exit (Col

5, lines 1-34 and Col. 5, lines 65 to col. 6, lines 42, discloses a means for determining an outgoing trunk group comprising outgoing port of the telephone calls to exit ATM network) and means for returning the address of the exit port to the entry port, or for forwarding the address of the entry port to the exit port, whereby the call can be switched directly through the ATM network (Col 6, lines 43-67, a port which receives an address of output port, has a memory for storing it in a routing table, wherein routing table includes an address of input port and an address of output port).

Regarding claim 2, Doshi discloses means connected to the means for identifying the exit port and to an STM switch for emulating an STM connection to the STM switch (Fig 1, Ref 225).

Regarding claim 6, Doshi discloses information for call identification is sent together with the address in order to correlate the address with the call (Col. 5, lines 1-19, the dialed number is used to identify address of output port).

Regarding claim 7, Doshi discloses (Figs 1-7 and col. 1, lines 14 to col. 11, lines 32) a unit for emulating a STM connection to a narrowband switch connected to a telecommunication network (Fig 6, Ref 245 and 255 or Fig 1, 210) comprising an ATM network comprising means for storing path requests received from the narrowband switch, means for acknowledging paths requests to the narrowband switch, and means for associating an incoming port with an outgoing port (Fig 6, Ref 255 or Fig 1, Ref 210 receives a call setup request from a narrowband switch telephone 25 and replies call setup request to the narrowband switch 25 and associating the incoming trunk with outgoing trunk in routing table; Col. 7, lines 31-63).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 5 and 8-13 rejected under 35 U.S.C. 103(a) as being unpatentable over Doshi (USP 5568475) in view of Nakagaki (USP 5452295).

Regarding claims 3, 5 and 12, Doshi fails to disclose the claimed invention. However, Nakagaki discloses means for establishing a new switched connection through the ATM network for each new telephone call by using ATM signaling and means for deciding if an already existing connection via the ATM network is to be used or if a new ATM connection is to be established (Fig 12, the telephone call is setup by ATM signaling and determined that if the old connect is disconnected by timer or not if yes establishing a new connection).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method for setup a telephone call via ATM network by using ATM signaling and determined if an old connection existed or not as disclosed by Nakagaki's system into Doshi's system. The motivation would have been to allocate a band for a telephone call.

Regarding claims 8-10, Doshi fails to disclose the claimed invention. However, the examiner takes an official noticed that a means for contacting broadband terminals connected to the telecommunication network; means for sending the address of one broadband terminal which includes the ATM End System Address (AES) to another broadband terminal connected to the

same network are well known and expected in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a means for contacting broadband terminals connected to the telecommunication network; means for sending the address of one broadband terminal which includes the ATM End System Address (AES) to another broadband terminal connected to the same network to Doshi's ATM network. The motivation would have been to utilize ATM network.

Regarding claims 11 and 13, Doshi discloses information for call identification is sent together with the address in order to correlate the address with the call (Col. 5, lines 1-19, the dialed number is used to identify address of output port).

### *Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Iwai (USP 5784371) discloses a method and apparatus for established a telephone call via ATM network.

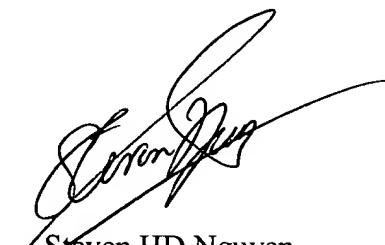
Civanlar (USP 5737333) discloses a method and apparatus for establishing a call from a telephone network via ATM network.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven HD Nguyen whose telephone number is (703) 308-8848. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D Vu can be reached on (703) 308-6602. The fax phone numbers for the

organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.



Steven HD Nguyen  
Primary Examiner  
Art Unit 2665  
January 24, 2003